

REMARKS

Claims 10, 12, 16, and 18 are canceled, new claim 24 is added, and therefore claims 8, 9, 11, 13 to 15, 17, and 19 to 24 are currently pending.

Reconsideration is respectfully requested based on the following.

It is noted that essentially corresponding claims (as previously presented) have been allowed in the corresponding European application. Furthermore, Examiner Blair spoke with Aaron C. Deditch (Reg. No. 33,865) on December 9, 2008, and advised that claims 20 to 23 (and any appropriate dependent claims) contained allowable subject matter.

Claims 10, 12, 16, and 18 were objected to under 37 CFR 1.75(c), as being of improper dependent form. Claims 10, 12, 16, and 18 have been canceled.

Claims 8 to 23 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 7,152,094 (the "Jannu" reference).

Further, to reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claims 10, 12, 16, and 18 are canceled.

Claims 8 and 14 provide that device includes the features in which bus-specific receiving objects are configured to one of (1) relay incoming messages to selected software gateways, and (2) monitor access to a particular bus, for each subnet, and in which the bus-specific receiving objects are provided for each subnet.

As further regards claims 8 and 14, they each include the features in which bus-specific receiving objects are configured to one of (1) relay incoming messages to selected software gateways, and (2) monitor access to a particular bus, for each subnet, and in which the bus-specific receiving objects are provided for each subnet. The Jannu reference does not disclose nor suggest these features. Indeed, the Office Action has not even addressed these specific features. For at least these reasons, claims 8 and 14 are allowable.

Still further, claim 8 is to a device for connecting subnets in a vehicle, including “a gateway unit configured to connect at least two subsystems,” in which the “gateway unit is made of at least one modular software gateway, which routes messages between only two subnets in a vehicle.”

The Final Office Action of April 7, 2009 -- which the present office action merely relies upon without further comment -- cites Figure 1 and column 1, lines 38 to 58, of the Jannu reference as to claim 8. In particular, it is conclusorily asserted that “connection 101-115 is considered a modular software gateway.” It is respectfully submitted that nothing in Jannu discloses (or even suggests) a modular software gateway, as provided for in the context of the presently claimed subject matter. The specification of the present application specifically states that a modular software gateway provides for “expand[ing] gateways without need for changing the existing gateway software and/or the existing configuration tables.” The present application further discloses that “[a]dding or omitting such a modular gateway when changing the network topology avoids such changes.” (*Specification*, page 1, lines 29, (emphasis added)).

In stark contrast, the Jannu reference merely states the following:

[I]f each type of technology uses its own data format, a *specifically designed adapter* is needed between each pair to allow communication between the two.... [T]he point-to-point approach creates vendor dependency. The adapters between platforms must meet the requirements of the manufacturers of each system. *If a piece of equipment is replaced, the adapters*

between the new equipment and all other systems must be redesigned.

(Jannu, col. 1, lines 51 to 58 (emphasis added)).

Thus, even if it is assumed (for purposes of this response) that elements 101 to 115 of the Jannu reference are gateways, as conclusorily asserted by the Final Office Action of April 7, 2009, the Jannu reference makes plain that it is not a “modular software gateway,” let alone one that is “connecting subnets in a vehicle,” as provided for in the context of the claimed subject matter. In Jannu, the “adapters between the new equipment” are not modular but “must be redesigned.” Thus, there is no reasonable interpretation that supports the assertion that the cited section of Jannu discloses a “modular software gateway” as in claim 8. This is because Jannu specifically teaches that its system is not modular.

In the Response to Arguments section of the Final Office Action of April 7, 2009 -- which the present office action merely relies upon without further comment --, the Office seems to suggest that Applicant’s are “confused” and even offers to clarify that the “claimed ‘module software gateway’ is the same thing as the [A]pplicant’s disclosed ‘logical software gateway’” (Final Office Action of April 7, 2009, page 2). It is respectfully submitted that the issue is not whether the “module software gateway” of the claimed subject matter is the same as what is in the present specification, but whether the Office has met its burden of presenting a *prima facie* case of obviousness by relying on the Jannu reference.

The Jannu reference does not describe, nor even suggest, the features as provided for in the context of the claimed subject matter. Although the Final Office Action of April 7, 2009 conclusorily asserts that “Jannu works the same way” (Final Office Action of April 7, 2009, page 3) it is merely relying on conclusory statements. In this regard, the Supreme Court has made clear that “rejections on *obviousness cannot be sustained by mere conclusory statements*; instead, there must be some articulated reasoning with *some rational underpinning* to support the legal conclusion of obviousness.” (See *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1396 (2007)). In contrast to the Supreme Court’s stated guidelines, the Office clearly has not provided any “articulated reasoning with *some rational underpinning* to support the legal conclusion of obviousness;” instead, the Office is relying on “mere conclusory statements.”

The Office’s arguments are essentially that “Jannu works the same way” and that “[A]pplicant is taking the words ‘all other systems must be redesigned’ out of context.” However, these assertions are belied by the fact that the section relied upon by the Final

Office Action of April 7, 2009 -- which the present office action merely relies upon without further comment -- makes absolutely clear that “[i]f a piece of equipment is replaced, the adapters between the new equipment and all other systems must be redesigned.” (Jannu, col. 1, lines 51 to 58 (emphasis added)). Prior art references must be considered as a whole, including portions that teach away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Accordingly, since there is no reasonable interpretation that supports the assertion that the cited section of Jannu discloses a “modular software gateway” as in claim 8, the Office has not met its burden of presenting a *prima facie* case of obviousness.

In the Response to Arguments section of the present Office Action, it is asserted that “the [A]pplicant has not disclosed anything specific about these features ...[and] to further prosecution, the applicant needs to explain what the novelty is supposed to be of the applicant’s invention.” (*Office Action*, page 2). Applicant’s don’t understand why the Office seems to contend that the disclosure is insufficient in the context of a 103 obviousness rejection. To the extent that the Office believes that the claimed subject matter is not supported by the specification (as it would be understood by a person having ordinary skill in the art,) the issue would fall under a 112 rejection. It is respectfully submitted that the Office has not rejected any claims under 35 U.S.C. § 112.

Further, in the Response to Arguments section of the present Office Action it is asserted that “[A]pplicant needs to explain how a bus-specific receiving object is different than the teachings of Jannu relied upon by the Examiner.” (*Office Action*, page 3). It is respectfully submitted that to reject a claim as obvious under 35 U.S.C. § 103, the Office bears the initial burden of presenting a *prima facie* case of obviousness. This it has not done. As discussed above, rejections on *obviousness cannot be sustained by mere conclusory statements*; instead, there must be some articulated reasoning with *some rational underpinning* to support the legal conclusion of obviousness.” (See *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1396 (2007)). Nevertheless, Applicants have provided all the foregoing arguments to explain that Jannu does not disclose or suggest all the features of the claimed subject matter. For example, as discussed above, Jannu fails to disclose the feature of a “modular software gateway, which routes messages between only two subnets in the vehicle,” as provided in the context of the claimed subject matter, because Jannu specifically teaches that its system is not modular.

Accordingly, claim 8, is allowable, as are its dependent claims 9, 11, 13, 22, and 23.

Claim 14, includes features like those of claim 8, including the feature of a “gateway unit configured to connect at least two subsystems, the gateway unit being integrated in a control unit having an application system and being provided in one layer of a communication system of the vehicle, the gateway unit including at least one modular logical gateway, the logical gateway connecting only the at least two subsystems in the vehicle, the subsystems being subnets.”

Claim 14, is therefore allowable for essentially the same reasons as claim 8, as are its dependent claims 15 to 21.

As further regards claim 20, it includes the feature of “bus-specific receiving objects configured to relay incoming messages to selected software gateways.” The Jannu reference does not disclose nor suggest this feature. Indeed, the Office Action has not even addressed this feature. For this additional reason claim 20 is also allowable. Still further, claim 20 includes the feature in which “the receiving objects include routing tables in which a treatment of incoming messages is configured.” The Jannu reference does not disclose nor suggest this feature. The Office Action has not addressed this feature. For this additional reason claim 20 is allowable.

New claim 24 does not add any new matter and is supported by the present application, including the specification. Claim 24 depends from claim 8, and is therefore allowable for the same reasons as claim 8.

As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

In the Response to Arguments section, the Office is apparently “not sure what the applicant is referring to” with regard to the requirements under MPEP § 2144.03.” (*Office*

Action, page 3). It is respectfully submitted that obviousness rejections without documentary evidence “should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration.” *MPEP* § 2144.03(A). As explained above, the Jannu reference does not disclose or suggest for example a modular software gateway. Further, the Office Action asserts that “Jannu could not function without [certain] features” and that “Jannu **must** have routing table.” (*Office Action*, pages 2 – 3, emphasis in the original).

As explained above, these assertions draw on facts within the personal knowledge of the Examiner. In this regard, *MPEP* § 2144.03 provides the following:

If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or examiner] must point to some **concrete evidence** in the record in support of these findings” to satisfy the substantial evidence test). If the **examiner is relying on personal knowledge** to support the finding of what is known in the art, **the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding.** See 37 CFR 1.104(d)(2).

(*MPEP* § 2144.03, emphasis added).

As further regards the obviousness rejections, the Federal Circuit in the case of *In re Kotzab* has made plain that even if a claim concerns a “technologically simple concept” — which is not believed to be the case here, there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed” to provide the advantages and/or benefits of the claimed subject matter, stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. *With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a*

skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper *prima facie* case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

(See In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Federal Circuit 2000) (italics added)). It is believed and respectfully submitted that there have been no such findings in the present case.

The cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), also make plain that the Office Action's generalized assertions that it would have been obvious to modify the references relied upon do not properly support a § 103 rejection. It is respectfully suggested that those cases make plain that the Final Office Action reflects a subjective “obvious to try” standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

....

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

(In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added)). Incredibly, the Final Office Action actually admits that it uses hindsight, and the obviousness rejections should therefore be reversed for that reason alone. (See Final Office Action, page 7, paragraph 5).

Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

(*In re Jones*, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted; italics in original)).

That is exactly the case here since it is believed and respectfully submitted that the Office Actions to date offer only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Accordingly, it is respectfully submitted that the assertions to date in this regard are insufficient since the Office must provide proper evidence of a motivation or suggestion for modifying a reference to provide the claimed subject matter.

As further regards all of the obviousness rejections, it is respectfully submitted that not even a *prima facie* case has been made in the present case for obviousness, since the Office Actions to date never made any findings, such as, for example, regarding in any way whatsoever what a person having ordinary skill in the art would have been at the time the claimed subject matter of the present application was made. (*See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998) (the “factual predicates underlying” a *prima facie* “obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art”)). It is respectfully submitted that the proper test for showing obviousness is what the “combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art”, and that the Patent Office must provide particular findings in this regard — the evidence for which does not include “broad conclusory statements standing alone”. (*See In re Kotzab*, 55 U.S.P.Q. 2d 1313, 1317 (Fed. Cir. 2000) (citing *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1999) (obviousness rejections reversed where no findings were made “concerning the identification of the relevant art”, the “level of ordinary skill in the art” or “the nature of the problem to be solved”))). It is respectfully submitted that there has been no such showings by the Office Actions to date.

In fact, the present lack of any of the required factual findings forces both Appellants and any Appeals Board to resort to unwarranted speculation to ascertain exactly what facts

underly the present obviousness rejections. The law mandates that the allocation of the proof burdens requires that the Patent Office provide the factual basis for rejecting a patent application under 35 U.S.C. § 103. (See *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967))). In short, the Examiner bears the initial burden of presenting a proper prima facie unpatentability case — which he has wholly failed to do in the present case. (See *In re Oetiker*, 977 F.2d 1443, 1445, 24, U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992)).

In short, there is no evidence that the references relied upon, whether taken alone, combined or modified, would provide the features of the claimed subject matter, as explained above. It is therefore respectfully submitted that the claimed subject matter is allowable for these reasons.

In view of the foregoing, claims 8, 9, 11, 13 to 15, 17, and 19 to 24 are allowable.

CONCLUSION

In view of the foregoing, all of the pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

~~Respectfully submitted,~~

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